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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,226	04/14/2005	Hiroshi Ono	KOD174B.001APC	1793

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EXAMINER

KRUER, KEVIN R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/509,226

Applicant(s)

ONO ET AL.

Examiner

Kevin R. Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/24/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 9/24/2004 has been fully considered. An initialed copy of said IDS is enclosed herein.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 55-039329A (herein referred to as Asahi).

Asahi teaches an ethylenic copolymer composed of ethylene and alpha-beta ethylenically unsaturated carboxylic acid wherein at least 10% of the acid is neutralized with a metal and/or ammonium ions. The copolymer comprise 90-97wt% ethylene, and 3-10mol% of unsaturated carboxylic acid and esters thereof (abstract). Said esters are understood to read on the claimed constituent c of claim 3. Said coating exhibits blocking resistance (herein understood to be synonymous with "slipping properties"). The "at least 10%" neutralization is understood to read on the claimed limitations of claim 4.

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5. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by JP51-04330A (herein referred to as Sumitomo).

Sumitomo teaches an ethylenic copolymer composed of ethylene and alpha-beta ethylenically unsaturated carboxylic acid wherein 20-100mol% of the acid is neutralized with amine and/or ammonium ions. The copolymer comprise 70-95wt% ethylene, and 5-30mol% of unsaturated carboxylic acid (abstract). Said neutralized acids are understood to read on the claimed constituent c of claim 3. Said coating exhibits blocking resistance (herein understood to be synonymous with "slipping properties"). The neutralization is understood to read on the claimed limitations of claim 4.

6. Claims 1-4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 55-040835(herein referred to as Asahi).

Asahi teaches paper coated with a lubricant comprising an ethylenic copolymer composed of ethylene and alpha-beta ethylenically unsaturated carboxylic acid wherein at least 10% of the acid is neutralized with a metal and/or ammonium ions. The copolymer comprise 90-97wt% ethylene, and 3-10mol% of unsaturated carboxylic acid and esters thereof (abstract). Said esters are understood to read on the claimed constituent c of claim 3. Said coating exhibits blocking resistance (herein understood to be synonymous with "slipping properties"). The "at least 10%" neutralization is understood to read on the claimed limitations of claim 4.

7. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al (US 6,120,655).

Ishii teaches a paper substrate coated with an ethylene-acrylic acid copolymer. The copolymer is applied in amounts of  $0.2\text{g/m}^2$  (example1). Said copolymer is understood to read on the claimed "slip property imparting agent" since it is compositionally identical to the claimed copolymer.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 10-12 are rejected under 35 U.S.C. 103(a) as being obvious over JP 55-039329A (herein referred to as Asahi), JP 55-040835(herein referred to as Asahi'835), or JP51-04330A (herein referred to as Sumitomo), as applied to claims above, and further in view of Kato et al (US 5,995,785).

Asahi, Asahi'835 and Sumitomo are relied upon as above, but do not teach the size of the copolymer particle. However, Kato teaches such lubricant typically have a particle size of .5-10um (col 6, lines49+). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize copolymer with a particle size of .5-10um. The motivation for doing so would have been that said particle sizes are known in the art to be useful as lubricants.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer  
Patent Examiner-Art Unit 1773